

HEAD et al
Appl. No. 10/561,901
August 27, 2008

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REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 31-60 are in the case.

I. ELECTION/RESTRICTION

The election of Group I is hereby affirmed. Claims 51-59 are withdrawn from consideration.

II. THE 35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Claims 31-37 stand rejected under 35 U.S.C. §112, second paragraph, in view of the use of the terms "optional" and "optionally". In response, those expressions have been deleted from the rejected claims.

In addition, the independent claims now require the gripping assembly to be "capable of holding the tubular patch at a desired location within the wellbore". The option that the gripping assembly can hold the patch at the desired location is disclosed at line 3 of page 7 of the application. No new matter is entered.

Withdrawal of the 35 U.S.C. §112, second paragraph, rejection is now in order. Such action is requested.

III. THE ANTICIPATION REJECTION

Claims 31-36, 38-43 and 60 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by US 2002/0185274 to Simpson et al. (Simpson). That rejection is respectfully traversed.

Claim 36 is directed to an apparatus for plastically expanding a tubular patch in a

HEAD et al
Appl. No. 10/561,901
August 27, 2008

wellbore. The apparatus comprises (a) a gripping assembly capable of holding the tubular patch at a desired location within the wellbore comprising at least one radially extendible gripping member for gripping the interior wall of the tubular patch and a mechanical means for radially extending the gripping member(s); (b) a rotatable expander tool, disposable in the tubular patch, comprising a plurality of expander elements radially extendible therefrom adapted to engage with the interior wall of the tubular patch and a mechanical means for radially extending the expander elements; and (c) at least one electric motor for supplying motive power to the mechanical means for radially extending the gripping member(s) of the gripping assembly, for supplying motive power to the mechanical means for radially extending the expander elements of the expander tool, and for providing rotation to the expander tool.

Simpson does not disclose (or suggest) a gripping assembly capable of holding the tubular patch at a desired location within the wellbore. Thus, the Simpson anchor assembly (625) prevents rotational movement of the housing (603) whilst allowing the apparatus (600) to move axially within the wellbore (see, para. 31, lines 3-5). The anchor assembly cannot, therefore, grip a tubular patch for installation in a wellbore.

In the presently claimed invention, the gripping assembly is capable of holding the tubular patch at a desired location within the wellbore and this enables the tubular patch to be run into a wellbore and expanded in the wellbore in a single operation. In contrast, this is not possible with the prior art apparatus, since the tubular must be run into the wellbore and hung from the tubular above in a first step before the apparatus (600) can be deployed into the wellbore.

HEAD et al
Appl. No. 10/561,901
August 27, 2008

In light of the above, it is clear that there is no disclosure of the invention as claimed. Simpson therefore cannot be anticipatory of the invention as claimed. Withdrawal of the anticipation rejection over Simpson is respectfully requested.

IV. THE OBVIOUSNESS REJECTIONS

Claims 44-46 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Simpson in view of Smalley et al. (US 6,142,230) or Vincent (US 3,203,451). Claims 47, 49 and 50 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Simpson in view of Cook et al. (US 2002/0050360). Claim 48 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Simpson

In response, Simpson neither discloses nor suggests the claimed invention for the reasons discussed above. The above-discussed deficiencies of Simpson are not cured by the secondary art to Smalley and Cook. In short, a person of ordinary skill would not have been motivated to arrive at the presently claimed invention based on Simpson taken alone or in combination with Smalley and/or Cook. Absent any such motivation, a *prima facie* case of obviousness has not been generated in this case. Withdrawal of the obviousness rejections is respectfully requested.

V. ALLOWABLE SUBJECT MATTER

It is noted, with appreciation, that claim 37 is allowable. With the above arguments and amendments, it is believed that all of the claims in the case are allowable. Early notice to that effect is requested.


HEAD et al
Appl. No. 10/561,901
August 27, 2008

Favorable action is awaited.

Respectfully submitted,

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